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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,233

02/19/2004

Ross Jonathan Hamel

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,233	Applicant(s) HAMEL, ROSS JONATHAN	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-87 is/are pending in the application.
- 4a) Of the above claim(s) 78-80,82 and 87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72-77,81 and 83-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 April 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 72-77, 81 and 83-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Standerwick et al. (3,072,118; of record) in view of Farley et al. (6,663,630).

Standerwick et al. disclose a fracture assembly comprising a reduction platform, e.g. 2, having receiving holes 28, a fragment manipulator, e.g. 8, having a bone engaging end 33, and a nut, e.g. 14, threadably and adjustably engaging the manipulator above the platform. The nut engages the top of the platform and the platform is between the nut and the bone engaging end of the manipulator. The second end of the manipulator includes a tool-engaging portion with a coupling surface 3. The

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manipulator includes a second outer diameter portion 30 that is larger than a first outer diameter portion 32 and comprises a diameter that is smaller than a receiving hole.

With regard to claim 72, the device is positioned over bone and the fragment manipulator is inserted through the reduction platform. (See, e.g., Fig. 1 and col. 3, line 14 - col. 4, line 27.) The fragment manipulator is inserted into bone. The nut is threaded onto the fragment manipulator and is made to contact the platform. The nut draws the manipulator upward during adjustment. Standerwick et al. disclose the claimed invention except for disclosing the use of threads. Farley et al. disclose a fixation system wherein threaded bone screws are used in place of pins in order to securely engage the skull and eliminate the danger of loosening skull pins (see, e.g.: Figs. 3-5, 7-9, 11 and 18; col. 1, lines 60-63; col. 2, lines 25-27, 32 and 33; col. 3, lines 42-45; col. 5, lines 51, 52, 56 and 57; col. 6, lines 14-16; and col. 7, lines 19-20, 65 and 66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the fracture assembly of Standerwick et al. with threaded bone screws instead of pins, in view of Farley et al., in order to securely engage the skull and eliminate the danger of loosening skull pins. The structure described in method claims 73-77, 81 and 83-86 has not been afforded patentable weight insofar as it does not affect the actual steps of the method, since it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). It is noted that the step of rotating the nut and drawing up the fragment manipulator and bone is inherently

satisfied in an ordinary use of the device of the combination, e.g, simply adjusting the nut to loosen or tighten it necessarily moves the fragment manipulator and bone in a corresponding manner. Any such movement toward the platform meets the claims.

Response to Arguments

Applicant's arguments filed 14 April 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious to have combined the devices for the reasons set forth above (i.e., to securely engage the skull and eliminate the danger of loosening skull pins). This motivation is provided by Farley et al. Moreover, in an ordinary use of the device of the combination, specifically in making adjustments to said device (*of the combination*), the fragment manipulator and bone would necessarily be drawn toward and away from the platform. Any movement toward the platform satisfies the claim language. This is manifestly evident and does not require any reference to Applicant's disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733